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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,001	06/26/2000	Peter Hossel	50105	2632

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EXAMINER	
FUBARA, BLESSING M	

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/604,001	HOSSEL ET AL.	
	Examiner	Art Unit	
	Blessing M. Fubara	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Examiner acknowledges receipt of remarks and amendment filed 02/17/04 and 08/05/04. Claims 1-15 are pending.

Claim Rejections - 35 USC § 102

1. The rejection of claims 1-5, 11 and 14 under 35 U.S.C. 102(b) as being anticipated by Uhl et al. (US 5,219,969) is withdrawn because of applicants' persuasive argument that at least 50% of acrylic acid or methacrylic acid is employed in Uhl while 0-40% by weight of unsaturated acid of anhydride is used in the present claims. However, there is no demonstration showing the relevance or criticality of using 40% by weight of unsaturated acid or anhydride in the instant claims. In the absence of such a showing, an obviousness rejection over Uhl is made below.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being obvious over Uhl et al. (US 5,219,969).

Uhl discloses water-in-oil emulsion and oil-in-water emulsion polymeric preparation wherein the preparation comprises divinylethyleneurea, N-vinylimidazole and 2, 2'-azobis (2-amidinopropane) dihydrochloride, and the polymerization of the monomers takes place by free radical process (abstract, column 4, lines 11-65, columns 9 and 10 and claims 1-5). Future intended use is not critical in composition claims. Future intended use is not critical in a composition claim.

Applicants admit that the difference between Uhl and the instant claims is that Uhl uses at least 50% or unsaturated acid while the claimed invention uses 0-40% unsaturated acid or

anhydride. However, this statement was not followed by a showing of criticality of 40% of the instant claims over 50% of Uhl. Since the differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating the concentration is critical, it is not inventive to discover optimum workable amounts by routine experimentation. It is noted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare and use the composition of Uhl. One having ordinary skill in the art would have been motivated to optimize the amount of the acrylic or methacrylic acid with the expectation of producing the desired cross-linked copolymer and in the absence of a showing, difference in amounts of the acrylic acid or methacrylic acid does not patentably distinguish the cross-linked copolymer of the instant claims over the cross-linked copolymer of Uhl.

4. The rejection of claims 1-14 under 35 U.S.C. 103(a) as being unpatentable over Tropsch et al. (US 5,869,032) in view of Kumar et al. (US 5,468,477) is withdrawn in light of applicants' persuasive argument. However, the rejection below is presented since Tropsch is still relevant to the claims.

5. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tropsch et al. (US 5,869,032).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but

not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Tropsch discloses a polymeric preparation that can be used in cosmetic compositions such as liquid soaps, body lotions, aftershaves, face lotion and other liquid formulation for skin. The polymeric preparation of Tropsch comprises 5-50% 1-vinylimidazole or quaternized 1-vinylimidazole (3-methyl-1-vinylimidazolium methylsulfate), 20-80% N-vinylcaprolactam, 10-60% N-vinylpyrrolidone, 2,2'-azobis(2-amidinopropane) dihydrochloride and polymerization of the preparation takes place by free radical polymerization; furthermore, the preparation contains perfume oils, emulsifiers, preservatives, collagen and vitamins (abstract, columns 1-4, formulations 1-10 and claims 1, 2, and 11-13). The composition of Tropsch is inherently an emulsion. The polymeric preparation of Tropsch comprises 1-vinylimidazole, quaternized 1-vinylimidazole, N-vinylcaprolactam, N-vinylpyrrolidone, 3-methyl-1-vinylimidazolium methylsulfate, 2,2'-azobis(2-amidinopropane) dihydrochloride and polymerization of the preparation takes place by free radical polymerization. Furthermore, the preparation contains perfume oils, emulsifiers, preservatives, collagen and vitamins. The composition of Tropsch et al. further comprises monomers selected from the group consisting of C_1-C_{12}-esters of acrylic or methacrylic acid, acrylamides and methacrylamides. See abstract, columns 1-4, formulations 1-

10 and claims 1, 2, and 11-13. Monomers of acrylic and methacrylic esters are capable of acting as crosslinkers (compare page 8, lines 8-10 of applicants' specification). Tropsch in column 2, lines 50-52 teaches hydroxyalkyl (meth) acrylates or alkylethylene glycol (meth) acrylates that have 1-50 ethylene glycol units in the monomeric unit. Glycol is a dihydric alcohol.

The composition of Tropsch also contains tert-butyl acrylate, ethyl acrylate or methacrylic acid (column 4, lines 15-18) and the acrylate ester meets the limitation of claim 1(e) except for the amount because Tropsch is silent on the amount of the acrylic ester and acrylic ester is listed in applicants' specification (page 8, lines 4-13) as monomer (e) of claim 1. The disclosed amounts of the imidazole, caprolactam and pyrrolidone fall within the claimed ranges. The difference between Tropsch and the instant claims is that Tropsch does not specifically disclose the amount of the acrylate (ester). But, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating the concentration is critical, it is not inventive to discover optimum workable amounts by routine experimentation. It is noted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare and use the composition of Tropsch. One having ordinary skill in the art would have been motivated to optimize the amount of the acrylic ester with the expectation of producing the desired composition and in the absence of a showing, difference in amounts of the acrylic ester does not patentably distinguish the instant composition over composition of Tropsch.

Double Patenting

6. The rejection of claims 1-14 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,869,032 (Tropsch et al.) in view of Kumar et al. (US 5,468,477) is withdrawn in light of applicants' persuasive argument. However the rejection below is relevant to the instant claims.

7. Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,869,032). Although the conflicting claims are not identical, they are not patentably distinct from each other because differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating the concentration is critical, it is not inventive to discover optimum workable amounts by routine experimentation.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claim 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 is recites "monomer mixture" but a mixture is not described but rather, single components are described in (a) to (d). Clarification is respectfully requested.

In claim 1, (b) cannot be (a); (d) cannot be (a), (b) or (c) and claim 15 which is dependent on 1 recites the same (a), (b), (c), (d) and (e) and it is not clear which of what is recited in claim 15 is applicable in claim 1. Clarification is respectfully requested.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara
Patent Examiner
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